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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,770	01/16/2001	Sumit Gupta	0007056-0073/P5380/RJL	7447

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EXAMINER

NGUYEN BA, PAUL H

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,770

Applicant(s)

GUPTA, SUMIT

Examiner

Paul Nguyen-Ba

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This action is responsive to:
 - a. Change in Power of Attorney, filed on September 27, 2004; and
 - b. Applicant's Amendment to First Office Action, filed on June 8, 2004.
2. Claims 1-20 have been considered. Claims 1, 10, and 18 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. ("426"), U.S. Patent No. 5,848,426, in view of Wang, U.S. Patent No. 5,113,445 ("445").

Independent Claim 1

'426 teaches a method for *converting a physical document into an electronic document* (see Abstract) wherein a data file of a first business system (i.e. computer programs) is encoded into a 2-D image code, consisting of format information (see col. 7 lines 55-60), which is printed out to a physical document (col. 3 lines 1-5; col. 4 line 13-

Art Unit: 2176

14; see also Figs. 4, 5, 7-10, 12) (compare with “*converting said initial electronic document...physical document...formatting commands*”);

the document in human readable form (i.e. *physical document*) is then scanned and the 2-D machine readable image code is then decoded (*compare with “interpret”*) to recover the format information on a second business system (see col. 4 lines 15-21) (compare with “*transform said physical document into said second electronic document in accordance with said formatting commands*”).

‘426 does not specifically teach *inserting the formatting command into an initial electronic document*. However, ‘426 teaches the preparation of a document with the 2-D formatting commands prior to printing the physical document (col. 6 lines 16-17). Furthermore, ‘445 also teaches the transferring of the 2-D graphic indicia on carrier means (i.e. electronic document) in response to the first transfer drive signals prior to printing the set of data to physical form in response to second transfer drive signals for the purpose of preparing an initial electronic document for printing into a physical electronic document.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of ‘426 with the teachings of ‘445 to include inserting the formatting command into an initial electronic document for the purpose of preparing an initial electronic document with formatting commands prior to converting the document into physical form.

Claims 2-8

‘426 teaches a method for converting a physical document into an electronic document (see Abstract) wherein a data file of a first business system (i.e. computer

Art Unit: 2176

programs) is encoded into a 2-D image code consisting of format information (see col. 7 lines 55-60) including pictorial and textural features extracted from the document (see col. 6 lines 29-32), but does not specifically teach wherein formatting commands are fonts, font sizes, alignment tags, tabs, margins, and table definitions.

However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art that "format information" specifies properties, particularly visible properties, of an object. For example, word processing applications allow you to format text, which involves specifying the font, alignment, margins, and other properties for the purpose of organizing and personalizing the contents of a document for visible display.

Claim 9

'426 teaches *placing one or more bar codes into said physical document wherein said bar codes are viewable representations of said formatting commands* (col. 5 lines 42-50; see also Figs. 4 and 5).

Independent Claim 10

With respect to independent claim 10, please refer to the rationale relied upon to reject independent claim 1.

Claim 11

Claim 11 incorporates substantially similar subject matter as claim 2, and is rejected along the same rationale.

Claim 12

Claim 12 incorporates substantially similar subject matter as claim 3, and is rejected along the same rationale.

Art Unit: 2176

Claim 13

Claim 13 incorporates substantially similar subject matter as claim 4, and is rejected along the same rationale.

Claim 14

Claim 14 incorporates substantially similar subject matter as claim 5, and is rejected along the same rationale.

Claim 15

Claim 15 incorporates substantially similar subject matter as claim 6, and is rejected along the same rationale.

Claim 16

Claim 16 incorporates substantially similar subject matter as claim 7, and is rejected along the same rationale.

Claim 17

Claim 17 incorporates substantially similar subject matter as claim 8, and is rejected along the same rationale.

Claim 18

Claim 18 incorporates substantially similar subject matter as claim 9, and is rejected along the same rationale.

Claim 19

With regards to claim 19, please refer to the rationale relied upon to reject independent claim 1.

Art Unit: 2176

Claim 20

With regards to claim 20, please refer to the rationale relied upon to reject independent claim 1. Furthermore, '426 teaches the method wherein said formatting commands are printed on a side of said physical document (see Figs. 7, 8, and 10).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached from 10:30 am - 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER